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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,595	03/11/2004	Li-Ying Yang	FDN-2795	6367
Attn: William J. Davis, Esq. GAF MATERIALS CORPORATION Legal Department 1361 Alps Road, Building No. 10 Wayne, NJ 07470			EXAMINER KATCHEVES, BASIL S	
			ART UNIT 3635	PAPER NUMBER
			MAIL DATE 10/10/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/798,595

**Applicant(s)**

YANG ET AL.

**Examiner**

BASIL KATCHEVES

**Art Unit**

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 2-4, 6, 7, 19-21, 23 and 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 5, 8-18, 22, 25-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of claims 1, 5, 8-18, 22, 25-31 in the reply filed on 12/20/07 is acknowledged.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 8, 10, 12, 13, 15 and 25 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,544,909. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Claims 1, 8, 10, 12, 13, 15 and 25 are substantially similar to claim 1 of '909.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 5, 8-12, 14-18, 25, 26, 28, 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,134,856 to Khan et al.**

Regarding claims 1, 10, 11, Khan discloses a roofing membrane (title) having a top and bottom layer (fig. 1: 14 & 16) and a scrim layer (12) made of fiberglass (column 2, lines 17-26), the bottom layer being embossed with alternating ridges and valleys, The layers pressed into one. Regarding the mechanically embossed limitation, the applicant should note that even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. However, Khan does not particularly disclose the ridges and valleys over the majority of the bottom layer. It would have been obvious to one having ordinary skill in the art at the time the invention was made to increase the area of ridges and valleys,

since it has been held that a mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. V. Bemis Co.*, 193 USPQ 8.

Regarding claim 5, Khan discloses the embossment pattern as random (fig. 1).

Regarding claims 8, 9, 25, Khan does not specifically disclose the top and bottom layers as being a polyolefin from polypropylene. However, Khan discloses the layers as optionally being polypropylene (column 2, lines 27-31). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use polypropylene, since it is an option disclosed by Khan and would have been an obvious design choice.

Regarding claim 12, Khan discloses the basic claim structure of the instant application but does not disclose specific dimensions of polyolefin (polypropylene) as stated in the claims. Applicant fails to show criticality for specifically claimed dimensions, therefore it would have been an obvious design choice to use the dimensions such as specified in these claims.

Regarding claim 14-18, Khan discloses the basic claim structure of the instant application but does not disclose specific dimensions. Applicant fails to show criticality for specifically claimed dimensions, therefore it would have been an obvious design choice to use the dimensions such as specified in these claims.

Regarding claim 26, Khan discloses a roofing membrane (title) having a top and bottom layer (fig. 1: 14 & 16) and a scrim layer (12) made of fiberglass (column 2, lines 17-26), the bottom layer being embossed with alternating ridges and valleys, Khan also discloses the making of the ply by applying the top and bottom in molten states (column

1, line 50) but not mechanical embossing. It would have been obvious to one having ordinary skill in the art at the time the invention was made to mechanically emboss the layers, since it is easier to apply a force to create a desired shape than to chemically create the same shape. However, Khan does not particularly disclose the ridges and valleys over the majority of the bottom layer. It would have been obvious to one having ordinary skill in the art at the time the invention was made to increase the area of ridges and valleys, since it has been held that a mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. V. Bemis Co.*, 193 USPQ 8.

Regarding claim 28, Khan discloses the polyolefin being polypropylene (column 2, line 28).

Regarding claims 30, 31, Khan discloses the ply as being capable of rolled (title) and for use on a roof (title). It would have been obvious to one having ordinary skill in the art at the time the invention was made to unroll the rolled roofing material upon a roof and secure it by fasteners to the roof, since that is the only way roofing material may be used upon a roof.

**Claims 13, are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,134,856 to Khan et al. in view of U.S. Patent No. 4,695,501 to Robinson.**

Regarding claim 13, Khan does not disclose the polyolefin as being of the group claimed by the applicant. Robinson discloses an insulative material having polyolefins of various types, One being epoxy polyethylene (column 3, lines 29-48). It would have

been obvious to one having ordinary skill in the art at the time the invention was made to modify Khan by using such a material since it is used as a flexible, insulative sheet.

**Claims 27 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,134,856 to Khan et al. in view of U.S. Patent No. 4,715,915 to Vanderzee.**

Regarding claim 27, Khan does not disclose the molten ply as being made by extrusion and calendaring with the ridges and patterns on a majority of the surface. However, Khan does not particularly disclose the ridges and valleys over the majority of the bottom layer. It would have been obvious to one having ordinary skill in the art at the time the invention was made to increase the area of ridges and valleys, since it has been held that a mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. V. Bemis Co.*, 193 USPQ 8. Vanderzee discloses a roofing material (column 2, line 23) made by extrusion and calendaring (column 3, lines 40-46)

Regarding claim 29, Khan discloses the polyolefin as being polypropylene (column 2, line 28), the addition of another layer of polypropylene would have been obvious to one having ordinary skill in the art at the time the invention was made since it has been held that a mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. V. Bemis Co.*, 193 USPQ 8.

### **Response to Arguments**

Applicant's arguments filed 6/16/08 have been fully considered but they are not persuasive. The applicant argues the claims as being allowable over Khan by the present amendment. This added limitation is addressed in the new rejection, necessitated by the applicant's amendment, above.

### **Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Basil Katcheves whose telephone number is



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(571) 272-6846. The examiner can normally be reached on Monday-Friday from 7:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot, can be reached at (571) 272-6777.

/Basil Katcheves/

Primary Examiner, Art Unit 3635